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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,888	01/10/2002	Jonas L. Steinman	I02.004	6273
8791 7590 08/23/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER RATHINASAMY, PALANI P	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,888	<b>Applicant(s)</b> STEINMAN ET AL.	
	<b>Examiner</b> Palani P. Rathinasamy	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10, 13-15, 20, 22, 23, 28, 29, 32, 34, 35, 37, 38, 41, 43-45, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 13-15, 20, 22-23, 28-29, 32, 34-35, 37-38, 41, 43-45, 56-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/2007 has been entered.

### ***Status of Claims***

2. This is in response to amendment filed 7/18/2007.
3. Claims 10, 14-15, 20, and 22-23 have been amended. Claims 10, 13-15, 20, 22-23, 28-29, 32, 34-35, 37-38, 41, 43-45, and 56-57 remain pending.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13 and 56 rejected under 35 U.S.C. 112, second paragraph, as lacking an essential method step. Independent claim 10, as broadly interpreted, refers to two advertisements that are not necessarily the same. Dependent claims 13 and 56 refer to "said advertisement" without referring to small form or large form. Independent claim 10 refers to "a small form of *an* advertisement" and a "large form of *an* advertisement".

(emphasis added) Since the advertisements do not have to be the same, the dependent claims are rendered unclear. Examiner recommends changing "large form of an advertisement" to "large form of an said advertisement."

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 10, 13, 14, 20, 22-23, and 57 are rejected under 35 U.S.C. 102(a) as being anticipated by Fredrickson et al. (US 2002/0019768 A1). Fredrickson et al. teaches of a method and system for managing advertisements.**

8. Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

9. Regarding claims 10, 22, and 23, Fredrickson et al. teaches of a method, system, and computer code for managing advertisements on a website. Fredrickson et al. gives sample screen shots of the website in Figures 1-40. ([0009]-[0047]). Applicant teaches that a 'brand component' on a Web Page "may include a single logo or trademark or a trademark in conjunction with brief text message." (2002/0143630, [0067]). Likewise, Fredrickson et al. shows a 'brand component' on a sample screen shot in Figure 21, (Fig. 21).

Fredrickson et al. shows a small form of an advertisement in another sample screen shot in Figure 22 as well as a large form of that advertisement in Figure 24. (Fig. 22; Fig. 24). Therefore, Fredrickson et al.'s screen shots show a brand component on a first web page (Fig. 21), a small form of an advertisement on a second web page (Fig. 22), and a large form of an advertisement on a third web page (Fig. 24).

10. Regarding claim 13, Fredrickson et al. shows in Figure 5 thumbnail versions of advertisements. (Fig. 5; [0058]). If a user wants to view the actual advertisement, a user clicks on the thumbnail to be connected to another page to see the full advertisement. ([0058]). Providing a clickable advertisement thumbnail is an indication of an opportunity to view.

11. Regarding claim 14, Figures 24 and 25 show a sample "Order Confirmation" page. (Fig.'s 24-25; [0032]). The confirmation page shows the original advertisements that were displayed to the user and confirms the user's order. ([0121]). Therefore, a user who accepts the order is confirming that they have viewed the advertisement prior to publication.

12. Regarding claim 20, Figure 24 shows a scroll bar implying that the web page is scrollable by the user. (Fig. 24).

13. Regarding claim 57, ¶¶'s 9 and 10 from above apply here.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**15. Claims 15 and 56, including amended claims, are rejected under 35 U.S.C. 103(a) as being anticipated by Fredrickson et al. (US 2002/0019768 A1) in view of Godin et al. (US 5,890,138).**

16. Regarding claims 15 and 56, Fredrickson et al. shows screen shots of displaying a brand component, small form of an advertisement, large form of an advertisement, and a confirmation page. (Fig.'s 1-40). As stated above, Fredrickson et al. shows a confirmation page that implicitly confirms that a viewer has viewed an advertisement.

Fredrickson et al. does not explicitly teach of displaying the confirmation page for a fixed time period. However, Godin et al. teaches of a displaying a confirmation screen that is displayed for a fixed time, namely two minutes. (Col 6, Lines 65-67). Like Fredrickson et al., Godin et al. teaches of an order confirmation page. (Col 6, Lines 37-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Fredrickson et al.'s teaching of a confirmation page with Godin et al.'s page of displaying the confirmation screen for a fixed amount of time. One would have been motivated for numerous reasons. A site implements a fixed amount of time to confirm an order in order to prevent open orders from sitting indefinitely. Additionally, it is done for security purposes in order to ensure that a user is still at the computer.

**17. Claims 28, 32, 35, 37, 41, and 44-45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 5,848,397) in view of JUNO ('Quarterdeck and Juno Announce Marketing Alliance', Business Wire, April 13, 1998).**

18. Regarding claims 28, 32, 35, 37, 41, and 44-45, Marsh et al. shows an example of the Juno software where a small version of an advertisement is displayed on the top of a browser and the full version is displayed underneath [Fig 4].

Marsh et al. does not explicitly teach that the full version of the advertisement prevents the small version from being seen. However, Juno teaches of "full screen pop-up" advertisements that are displayed to a user. It is old and well known that a pop up advertisement is an advertisement that appears on a new screen. Full screen occurs when the advertisement occupies the entire computer screen. A full screen pop up advertisement is an advertisement that appears in a new screen and covers the entire screen so that other items are no longer visible. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added to Marsh's teaching of two types of advertisements with Juno's teaching of a full screen pop up advertisement on top of another advertisement. One would have been motivated to combine in order to force viewers to see the entire screen. It is also noted that Marsh et al. and the article are both Juno products.

**19. Claims 29, 34, 38, and 43, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 5,848,397) in view of JUNO ('Quarterdeck and Juno Announce Marketing Alliance', Business Wire, April 13, 1998) in further view of JAVA SCRIPT programming ("Java Script", Ready, 1996 New Riders Publishing). JAVA SCRIPT teaches coding methods for creating interactive web sites and is a standard method for creating advertisements in web domains.**

20. Regarding claims 29, 34, 38, and 43, Marsh et al. teaches of displaying advertisements on a webpage. Juno teaches of providing full screen pop up advertisements.

Marsh et al. and Juno do not explicitly teach that the second page is not resizable by the viewer. However, JAVA SCRIPT is a standard method for creating interactive web pages that display, amongst other things, advertisements (see figures on page 33). In JAVA SCRIPT coding, the switch "resizable" controls "whether the window can be resized" [JAVA SCRIPT, page 32]. Therefore it would have been obvious to one skilled in the art to display Marsh et al.'s advertisements using JAVA SCRIPT and prevent the advertisement window from being resized. One would have been motivated to do so in order to "[define] an exact-sized window for galleries, control pads and other purposes." [JAVA SCRIPT, page 32]. Additionally, one would have wanted to prevent a visitor from resizing the window in order to ensure that the advertisement is viewed at full screen.



### ***Response to Arguments***

21. Applicant's arguments with respect to claims 10, 13-15, 20, 22-23, 28-29, 32, 34-35, 37-38, 41, 43-45, and 56-57 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns, line numbers, and paragraphs in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing responses, fully consider each of the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art disclosed by the examiner.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
PPR

  
**ARTHUR DURAN**  
**PRIMARY EXAMINER**